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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/128,304 08/03/98 WILLIS

N CRDP-2700

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EXAMINER

0M32/0328

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MANTIS MERCADER, E  
ART UNIT PAPER NUMBER

3737  
DATE MAILED:

03/28/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. 09/128,304	Applicant(s) Willis et al.
	Examiner Eleni Mantis Mercader	Group Art Unit 3737

Responsive to communication(s) filed on Jan 2, 2001

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-58 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-58 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Note to Applicants: Claims 59 and 60 are not in proper format for entry. The newly added claims must not be underlined. Please make appropriate corrections.

#### *Specification*

1. The attempt to incorporate subject matter into this application by reference to 08/905,090 and 08/732,511 is improper because the incorporation of essential material by reference to another application is improper.
2. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material

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incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheehan et al..’466.

Sheehan et al.’466 teach generating a three dimensional model of a region of interest, determining the three-dimensional location of a physical characteristic in the region of interest using at least one probe positioned within the living body, deforming the model to at least approximately incorporate the physical characteristic at the determined three dimensional location, wherein the heart model is deformed in order to superimpose the coronary artery on the heart model and displaying the model on a graphical (col. 5, lines 57-67; col. 6, lines 1-67; and see Figures 10 and 13). Sheehan et al.’466 does not teach the use of fluoroscopy, instead ultrasound is used. Lacking any criticality, use of one imaging modality over the other would have been an

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obvious matter of design choice to one skilled in the art at the time that the invention was made since they are both used as functional equivalents in determining the position and orientation of the probe.

*Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicants are invited to comment on the relevancy of the following patents:

Panescu et al.'532 teach systems for recording use of structures deployed in association with heart tissue.

6. Please note that Examiner has not received the non-patent literature as indicated in the IDS statement. Please supply a copy of those references with your next correspondence so that those documents can be considered.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni Mantis Mercader whose telephone number is (703) 308-0899. The examiner's supervisor, Mr. Marvin Lateef, can be reached on (703) 308-3256.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. The fax phone number for this group is (703) 308-0758.

  
EMM

March 21, 2001.

  
Marvin M. Lateef

Supervisory Patent Examiner  
Group 3700